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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/665,529      09/19/00      TOBINICK      E      TOBINICK 3.0

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HM22/0510

EXAMINER

JARVIS, W

ART UNIT

PAPER NUMBER

1614

DATE MAILED:

05/10/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/665,529

Applicant(s)  
Tobinick

Examiner  
William R. A. Jarvis

Art Unit  
1614



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 30-49 and 98 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-49 and 98 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 1 20) ☐ Other:

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 30-49 and 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sadun et al, Dick & Duncan et al, Dick & McMenamin et al, or Sippy et al. Sadun teaches that pentoxifylline and other tumor necrosis factor antagonists are effective at treating AIDS-associated optic neuropathy including optic neuritis; see columns 3-5 and the claims in particular. The two Dick references teach that inhibition of TNF-alpha prevents retinal destruction in experimental autoimmune uveoretinitis. Sippy teaches that TNF has been implicated in the pathogenesis of several retinal diseases and that soluble TNF receptors are present in human vitreous humor. Applicant's claims differ in that they require TNF antagonists not specifically mentioned by the prior art. However, since the prior art teaches that various TNF antagonists are effective at treating conditions of the optic nerve and retina, one skilled in the art would have been motivated to treat these ophthalmic disorders with any type of TNF antagonist. One skilled in the art would have been motivated to treat macular degeneration, retinitis pigmentosa, or diabetic retinopathy with TNF antagonists since the skilled artisan typically treats conditions having a common etiology with the same or similar drugs. The claimed amounts and modes of administration are obvious since it is within the skill of the artisan to determine the modes of

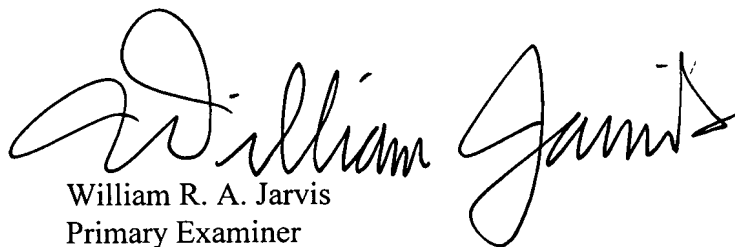
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administration and amount of drug that provides the therapeutic effect required by the patient while minimizing adverse side effects.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William R. A. Jarvis whose telephone number is (703) 308-4613. My normal office hours are Monday, Tuesday, Thursday, and Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Cintins, can be reached on (703) 308-4725. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink that reads "William Jarvis". The signature is written in a cursive, flowing style with a large initial "W" and a long, sweeping underline.

William R. A. Jarvis  
Primary Examiner  
Art Unit 1614  
May 5, 2001